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10/612,740	07/02/2003	John E. Cahill	68743	5726

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EXAMINER

PICKETT, JOHN G

ART UNIT PAPER NUMBER

3728

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/612,740

**Applicant(s)**

CAHILL, JOHN E.

**Examiner**

Gregory Pickett

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/2/03</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. In the IDS filed on 2 July 2003, documents AH, AZ, and BA were not considered by the examiner. The document numbers appear to be incorrect since the names on the references do not correspond to those supplied on the Form PTO-1449 and the subject matter is not relevant to the instant application.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the reinforcement members of claim 17 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement

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Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-33 and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the claim lacks a transitional phrase. As such, it is unclear as to whether the structure following the semi-colon corresponds to the objects or the carton. To prosecute the examination of the claims on their merits, the examiner assumes the following transitional phrase to be inserted prior to the semi-colon, "said carton comprising".

Claims 2-32 are dependent on claim 1 and are rejected for the above reason.

Claim 33 recites the limitation "said first and second fold lines" in line 13. There is insufficient antecedent basis for this limitation in the claim. The examiner assumes the blank to include the scoring of only one fold line, since the second fold line is defined in claim 34.

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Claim 36 recites the limitation "said first and second fold lines" in line 10. There is insufficient antecedent basis for this limitation in the claim. The examiner assumes the method to include the scoring of only one fold line.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-7, 18, 20, 25, 26, and 30-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Bowland (US 4,856,652).

Regarding claim 1, Bowland discloses a carton (Figures 1-3) comprising a generally triangular first panel **18**; a generally triangular second panel **16 & 12**; and a one-piece peripheral wall **19**. Bowland is shaped and functions as claimed.

As to claims 2-5, 20, 31, and 32, the applicant does not positively recite the objects retained. Bowland is capable of retaining the claimed objects.

As to claims 6 and 7, Bowland discloses integral handle **13**.

As to claim 18, Bowland anticipates paperboard (see Col. 2, lines 50-55).

As to claims 25 and 26, Bowland discloses the retention of six objects **15a & 14**.

As to claim 30, Bowland discloses peripheral engaging portion **16** and closure portion **12**.

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5. Claims 1-5, 8, 11, 18, 20, 31, and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Inman (US 1,996,997).

Regarding claim 1, Inman discloses a carton (Figures 1-3) comprising a generally triangular first and second panel **15** and a one-piece peripheral wall **10a**. Inman is shaped and functions as claimed.

As to claims 2-5, 20, 31, and 32, the applicant does not positively recite the objects retained. Inman is capable of retaining the claimed objects.

As to claim 8, Inman discloses overlapping first and second ends of the peripheral wall (see Col. 2, lines 4-7).

As to claim 11, Inman discloses the overlap in one of the corners (see Figure 2).

As to claim 18, Inman discloses paperboard (see Col. 3, lines 30-33).

6. Claim 9 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Inman (US 1,996,997).

Claim 9 is a product by process claim. The securing via thermo-sealing does not result in a structural difference from the carton of Inman and is therefore anticipated by Inman. The method of forming the device is not germane to the issue patentability of the device itself. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

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7. Claims 33 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Ressinger (US 2,166,265).

Regarding claim 33, Ressinger discloses a carton sidewall blank (Figure 6) having a generally rectangular main portion **1** with a first fold line **4a** and a plurality of fold lines **1a** running perpendicular to fold line **4a**. The blank of Ressinger is capable of use in the claimed manner.

As to claim 34, Ressinger discloses second fold line **5a**.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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8. Claims 1-5, 20, 21, 24, 31, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller (US 1,236,589) in view of Rous (US 2,173,494, supplied by applicant).

Regarding claim 1, Miller discloses a carton (Figures 1-4) comprising a first panel **C** with rounded corners; a second panel **G** with rounded corners; and a one-piece peripheral wall **A**. Bowland functions as claimed.

Miller merely lacks a generally triangular shape.

Rous discloses that it was known in the art at the time the invention was made to provide bottle carriers in a triangular shape. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the carton of Miller in a triangular shape in order to stack the cartons horizontally (as seen in Rous, Figure 2). A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

As to claims 2-5, 20, 31, and 32, the applicant does not positively recite the objects retained. Miller-Rous is capable of retaining the claimed objects.

As to claim 21, Miller-Rous discloses openings (Miller **g**).

As to claim 24, Miller-Rous discloses the retention of six articles (Rous, Figure 1).

9. Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller-Rous as applied to claim 21 above, and further in view of Wood (US 3,348,671).



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Miller-Rous discloses the claimed invention except for the slits.

Wood discloses slits **8** in bottle retaining apertures. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the carton of Miller-Rous with slits as taught by Wood in order to better grip the bottles during transport.

10. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Inman (US 1,996,997).

Inman discloses the claimed invention except for the seam being in the straight portion. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the seam in the straight portion, since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70. The invention would perform equally well with the seam in either position.

11. Claims 6, 7, and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inman (US 1,996,997) in view of Holmberg (US 2,853,186).

Inman discloses the claimed invention except for the handle.

Holmberg discloses a handle **34** on a peripheral strap **18b** used to retain cylindrical objects **12**. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the carton of Inman with a handle as taught by Holmberg in order to assist the user in carrying the carton.

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12. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inman-Holmberg as applied to claim 13 above, and further in view of Allred (US 3,392,876).

Inman-Holmberg discloses the claimed invention except for the handle reinforcements.

Allred discloses a handle with first panel 21, second panel 22, and reinforcement 25. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the handle of Inman-Holmberg with reinforcements as taught by Allred in order to enable the carrying of heavy objects.

13. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bowland (US 4,856,652) in view of Bruce (US 2,996,180).

Bowland, as applied to claim 1 above, discloses the claimed invention except for the indicia on the sidewall.

Bruce discloses indicia on the side of a package. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the carton of Bowland with indicia as claimed by the applicant in order to inform the user of the articles retained.

14. Claims 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bowland (US 4,856,652) in view of Brown et al (Des. 317,261).

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Bowland, as applied to claim 1 above, discloses the claimed invention except for the removable second panel and the rolled reinforcement rim.

Brown et al discloses a separate end panel (see Figure 7). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the end panel 15 separate, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPO 177, 179.

As to the rolled, reinforcement rim, Brown et al disclose such a rim (see Figure 7). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the sidewall of Bowland with a rim as taught by Brown et al in order to provide a positive engagement portion for the attachment of the end panel.

15. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ressinger (US 2,166,265) in view of Beaty (Des. 436,534).

Ressinger, as applied to claim 33 above, discloses the claimed invention except for the handle.

Beaty discloses a handle for a blank. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the blank of Ressinger with a handle as taught by Beaty in order to assist the user in carrying the retained articles.

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16. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Inman (US 1,996,997) in view of Li Vigni et al (US 6,592,023).

Inman discloses forming a sidewall blank (Col. 2, lines 1-3); scoring a first fold-line (16, see Col. 2, lines 38-41, the strip above line 16 being capable of folding); bending the sidewall blank into a tubular carton (see Col. 2, lines 4-10); and closing an end of the carton by attaching a triangular panel 15.

Inman discloses the claimed method except for the provision of a separate end panel and the provision of a plurality of perpendicular score lines.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the end panel 15 separate, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPO 177, 179.

As to the perpendicular score lines, Li Vigni et al discloses scoring a paperboard with lines 69' parallel to the bend radius. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the sidewall of Inman with perpendicular score lines as taught by Li Vigni et al in order to produce tighter bend radii.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 703-305-8321. The examiner can normally be reached on Mon-Fri, 9:30 AM - 6:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Greg Pickett  
Examiner  
2 September 2004

  
Mickey Yu  
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Group 3700